

Appl. No. 09/574,009
Amend. dated 10/15/2003
Reply to Office Action of 07/15/2003

Remarks/Arguments

The Applicant respectfully requests reconsideration of this application as amended. Claims 1-11, 13-15, 17-18, 22, 27-28, 30-32, 37-46, 50 and 55 have been amended without prejudice to increase the clarity of such claims. Claims 12, 16, 19-21, 23-26, 29, 33-36, 47-49, 51-54 and 56-61 have been canceled without prejudice. Nine new claims, claims 62-70, have been added. Therefore, claims 1-11, 13-15, 17-18, 22, 27-28, 30-32, 37-46, 50, 55 and 62-70 are present for examination. Applicant respectfully submits that no new matter has been added by this amendment.

Election/Restrictions

In the Office action, the Examiner has indicated restriction to one of three different groups of purported "subcombinations" is required under 35 U.S.C. § 121. The undersigned respectfully traverses. As an initial matter, as understood by the undersigned, in accordance with Statute, the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. 35 U.S.C. § 121. However, a proper requirement for restriction between patentably distinct inventions requires the Examiner to provide reasons and/or examples to support conclusions regarding the following: (i) the inventions must be independent or *distinct* as claimed; and (ii) there must be a *serious burden* on the Examiner (Emphasis added. See MPEP at § 803).

The undersigned respectfully submits the Examiner has not made a prima facie showing with respect to either of the above-noted requirements. For example, with respect to the "serious burden" prong, the Examiner has not shown by appropriate explanation that the claims fall within separate classifications, have separate status in the art, or are in different fields of search. In fact, *the Examiner admits in the Office action that all purported "subcombinations" would be classified in class 705, subclass 26* (see pg. 2 of the Office Action). If the search and

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examination can be made without serious burden, the Examiner must examine the application on the merits, even though it includes claims to independent or distinct inventions. MPEP § 803. For at least this reason, the undersigned respectfully requests the Examiner to withdraw the restriction requirement.

With respect to the "independent or distinct as claimed" prong, as understood by the undersigned, "two-way distinctiveness" must be demonstrated to establish subcombination inventions are distinct. See MPEP 806.05(c). Further, to support a requirement for restriction, in addition to two-way distinctness, the Examiner must also provide reasons for insisting on restriction, i.e., *separate classification*, status, or field of search. *Id.* Neither of these two required showings have been made by the Examiner. Rather, the Examiner states "subcombinations are distinct from each other if they are shown to be separately usable" (citing MPEP § 806.05(d)).

Without debating the correctness of the test chosen by the Examiner, it is respectfully submitted that the Examiner has nevertheless misapplied the "separately usable" test. In support of his view on separate usability, the Examiner has merely pointed to limitations included in claim 30 that are not expressly recited by the independent claims of Group I and Group III, i.e., "Invention II has separate utility such as completing a full loop, by matching consumers to only those pre-qualified service providers who have confirmed their interest in performing the requested service." However, the matching of consumers to service providers is precisely the disclosed and intended use of the purported subcombinations of Groups I and III in the specification as well. To the extent MPEP § 806.05(d) provides the proper test for restriction in the instant case, the undersigned respectfully submits it is not intended as a license for Examiners to restrict claims merely for having more or fewer limitations. Rather, it is clear from the MPEP that the burden is on the Examiner to document viable alternative uses for the purported subcombinations or withdraw the requirement. *Id.*

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The claims identified as Group I and III, while not specifically reciting the matching step, are intended for use in a method of matching consumers to service providers. For example, claim 1, as amended, recites "establishing a database of pre-screened home service providers; extracting a description of a consumer's service needs ... packaging and presenting the consumer's service needs to one or more home service providers ... and ... presenting one or more affirmative home service provider responses to the consumer..." With respect to Group III, claim 37, as amended, recites the following "developing a detailed description of the consumer's service needs ... enabling the consumer to one or more of receive, obtain and solicit information from a plurality of pre-screened home service providers by presenting the consumer's service needs as a service request to each of the plurality of pre-screened home service providers ... and compiling a list of pre-qualified home service providers who have confirmed their interest in meeting the consumer's service needs or who have otherwise shown interest in services similar to the consumer's service needs..." Such steps of claims 1 and 37 are intended for use in and/or with the methods recited by claim Group II and are disclosed as such by the specification. (See, e.g., Brief Summary of the Invention pg. 4). For at least these reasons, the undersigned respectfully submits the Examiner has not met his burden of establishing viable alternative uses for the purported subcombinations of Groups I, II and III. Consequently, the undersigned respectfully requests the Examiner to withdraw the restriction requirement.

Despite the great weight of evidence against doing so, to the extent the Examiner maintains his restriction requirement, the undersigned elects with traverse Group II (including new claims 62-70) for examination.

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Brief Comments on New Limitations

For the convenience of the Examiner and to obviate a new matter rejection, the undersigned would like to briefly point out the new limitations in claims 46 and 62 relating to (i) withholding of personally identifiable information relating to the consumer when presenting the home improvement task to the home service providers; and (ii) providing the consumer's contact information only to the first predetermined number of home service providers to accept are supported by at least the original disclosure in Appendix A at pg. 58-59 and Appendix A at pg. 73.

Conclusion

Applicant respectfully submits that the rejections have been overcome by the amendment and remark, and that the claims as amended are in condition for allowance. Accordingly, Applicant respectfully requests that the rejections be withdrawn and that a Notice of Allowance be issued for claims 1-11, 13-15, 17-18, 22, 27-28, 30-32, 37-46, 50, 55 and 62-70.

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Request for an Extension of Time

The Applicant respectfully petitions for a two-month extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. 1.136(a). Enclosed is a credit card authorization in the amount of \$210.00 to cover the necessary fee under 37 C.F.R. 1.17(a). Please charge our Deposit Account No. 06-0029 for any additional charge associated with such an extension.

Invitation for a Telephone Interview

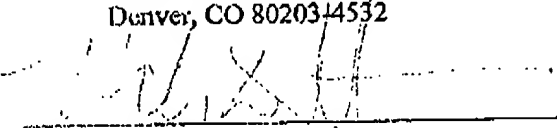
The Examiner is requested to call the undersigned at (303) 607-3633 if there remains any issue with allowance of the case.

Charge our Deposit Account

Please charge any shortage to our Deposit Account No. 06-0029

Respectfully submitted,
FATGRE & BENSON LLP
3200 Wells Fargo Center
1700 Lincoln Street
Denver, CO 80203-4532

Date: October 15, 2003


Michael A. DeSanctis
Reg. No. 39,957
Telephone: 303-607-3633
Facsimile: 303-607-3600

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